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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,630	03/14/2001	Phillip Dan Cook	ISIS-4718	2799

32650 7590 10/15/2003

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EXAMINER

EPPS FORD, JANET L

ART UNIT	PAPER NUMBER
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1635

11

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,630

Applicant(s)

COOK ET AL.

Examiner

Janet L. Epps-Ford, Ph.D.

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15 and 17-47 is/are pending in the application.
- 4a) Of the above claim(s) 2-15, 17, 18 and 20-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 34-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Sequence Listing

1. The sequence listing submitted by Applicants on 7-25-03 is considered technically sound, and has been entered in to the Sequence Databases of the STIC division of the USPTO.

Election/Restrictions

2. Claims 2-15 and 17-18, and 20-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.
3. Applicant's election with traverse of invention II, claims 19 and 34-47, in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the Examiner has not established a serious search burden. This is not found persuasive because according to MPEP § 803, "For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." As set forth in the prior restriction requirement, separate classification was previously established; the invention according to group I was classified in 435/375, and the invention of group II was classified in 435/6.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19, and 34-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 19, and 34-47 recite a method of assaying a nucleic acid, comprising contacting a solution suspected to contain said nucleic acid with a compound, wherein the compound is described as set forth in claim 19. However, the method recited in claim 19 and those claims dependent therefrom, is incomplete since the claimed method does not set forth any steps wherein the nucleic acid is assayed. For example, there is no relationship set forth between the compound and the nucleic acid that is assayed, such that it is immediately obvious that the contacting step, which comprises contacting a solution containing said nucleic acid, represents an active step which comprises contacting said compound with said nucleic acid, wherein said nucleic acid is assayed for. The method does not even require that the compound comprise a sequence of nucleosides such that said sequence is complementary to the nucleic acid that is to be assayed. Moreover, there is no concluding step included with this method, wherein said concluding step correlates the steps recited in the method with the desired outcome as set forth in the preamble of the claimed method.

Closest Prior Art

7. It is noted that the compounds of the present invention used in the methods recited in the instant claims were rejected under 35 USC § 103(a) as being unpatentable over Cook et al. in view of Sanghvi et al. during the prosecution of parent application 09/115,027. However, this rejection was withdrawn in view of Applicant's argument that the prior art lacks sufficient motivation for combining the prior art to make the claimed compounds in the exactly claimed form. Moreover, since the compounds recited in the issued patent US 6,242,589 were considered allowable over the prior art, the claimed method of using these compounds is considered free of the prior art.

Conclusion

8. Claim 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

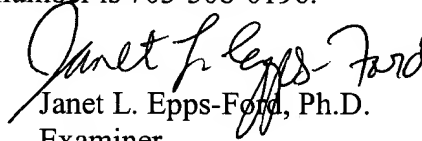
9. Claims 34-47 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 1635

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford, Ph.D. whose telephone number is 703-308-8883. The examiner can normally be reached on Monday-Thursday, 8:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 703-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Janet L. Epps-Ford, Ph.D.
Examiner
Art Unit 1635

JLE

October 14, 2003